

REMARKS

This Response is submitted in response to the final Office Action dated March 26, 2003. The specification and Claims 13 and 17 have been amended. Applicant respectfully requests entry of the amendments because the amendments place the claims in better condition for appeal and no new matter has been added.

The Office Action re-asserts that the title of the invention is not descriptive, and suggests the following title: "Context Sensitive Help For Gaming Machines That Provides Paytable Information Concerning A Game Symbol When the User Selects The Symbol On The Display." Applicant respectfully disagrees with the suggested title because the language is extraneous to the present specification. In particular, the term "Context Sensitive Help" does not appear in the specification. Although the original title is believed to be clearly indicative of the invention to which the claims are directed, Applicant is hereby amending the title to provide a title that might be more informative for the U.S.P.T.O. purposes of indexing, classifying, searching, etc.

Claim 13 was objected to due to noted informalities. The amendment made to this claim herein is believed to address and resolve this objection. Applicant notes, however, that the phrase "and the step of sequencing said payable" is not superfluous, as asserted in this objection. Applicant believes that the deletion of the words "the step of" serve to enhance the readability of this claim and cure any objection to this particular claimed element.

Claim 18 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The dependency of Claim 18 has been amended to overcome this rejection and not for the purposes of distinguishing over the prior art.

The Office Action rejected Claims 1-8, 11-24, 26-32, and 34-48 under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Lemay and Fey. Applicant respectfully disagrees with this rejection and traverses based on the following reasons.

I. All Elements of the Claims are Not Taught By the Prior Art

The Office Action maintains in rejecting Claims 1, 3, 4, 7, 11, 42 and 43-46 the assertion that Heidel teaches a game controller, a display device attached to the controller, at least one reel displayed on the display device, at least one symbol displayed on the reel, and a touch screen connected to the controller for selecting a symbol. The Office Action further asserts that Heidel discloses "a payable display for the symbol stored in memory" and that "Heidel teaches displaying the payable when the player pushes the payable area of the screen, not when the player selects a symbol." However, Heidel states that the display device displays "a payable 18 that provides the player with the values for various winning combinations of cards." (Col. 2, lines 24-29). Heidel does not disclose touching a payable area on the screen to display a payable. It is, however, recognized that "Paytable," "See Pays," and "Help" buttons or inputs, which, when activated, cause the display device to reveal the first of multiple screens of the entire payable for all of the symbols were known in the art prior to the present invention.

This is not the present invention. Claim 1, for example, features selection of an individual symbol on a reel that causes the display of a payable associated with that selected symbol. Heidel and the recognized prior art clearly do not disclose, teach or suggest the selection of a specific symbol on a reel that causes the display of the payable or more specifically the part of the payable associated with that specific selected symbol. Thus, all of the elements of Claim 1, as well as the other claims, are not specifically taught or suggested by Heidel or the other recognized prior art.

II. Lack of Suggestion or Motivation to Combine

To ostensibly supply the elements of Claim 1 (and the other claims) recognized as missing from Heidel, the Office Action relies on Lemay and Fey. With respect to Lemay and Fey, the Office Action explains that "Fey teaches the traditional appearance of the payable" and Lemay teaches that "[h]yperlinked, context sensitive help is well known in the art." The Office Action generally concludes that there is a motivation for

combining Lemay and Heidel because the hyperlinks of Lemay make gaining payable information quicker, leading to more time spent gambling by players, in turn leading to greater casino profits. However, the Office Action does not state a specific motivation because as discussed below there is no motivation or suggestion in these references to combine the idea of hyperlinking with an entire payable request input and then to change the input to be a specific symbol and then to change the portion of the payable displayed (when that specific symbol is selected) to be the part of the payable specifically for that symbol.

A. Proper Source of Motivation or Suggestion to Combine is Lacking

Applicant submits that a proper source of motivation or suggestion to combine the cited references and to modify those references to create the present invention is lacking. To establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention (see M.P.E.P. § 2143.01). The Federal Circuit has said that "there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Office Action has not established a valid source of motivation from any of these three potential sources.

With respect to the first source of motivation, the nature of the problem to be solved would not reasonably direct one of ordinary skill in the art to look to Web publishing technology for a solution as will be discussed below with regard to the non-analogous nature of Lemay. This reference's teachings of Web publishing would not reasonably direct one of ordinary skill in the art seeking to solve the problem of sorting through unwanted payable symbols and combinations in a gaming device to find a desired symbol or combination.

Regarding the second source of motivation, the prior art of record is absent of any teachings, either explicit or implicit, to combine the cited references to arrive at the presently claimed invention. That is, Heidel merely teaches the display of a single payable for various winning card combinations. Heidel is devoid of any teaching or

suggestion to display a payable of a particular card (i.e., a symbol) when that card (i.e., symbol) is selected. Fey does not provide any teaching or suggestion for this feature and Lemay contains no teaching or suggestion even pertaining to gaming devices and, more particularly, to displaying the appropriate portion of a payable associated with a selected symbol displayed on a reel. Thus, the prior art presented in the Office Action provides no source of motivation to combine the references to arrive at the present claims.

Further, contrary to the asserted motivation for combining Lemay and Heidel (i.e., the hyperlinks of Lemay make gaining payable information quicker), the continuously displayed payable of Heidel provides necessarily quicker payable information than combining Heidel with Lemay's hyperlinks to access and display such information. Heidel's payable is continuously displayed and combining Heidel and Lemay would add unnecessary steps to display the payable, thus running contrary to the goals of the stated motivation. Thus, the Office Action's suggested motivation for combining Heidel and Lemay's hyperlinks to display payable information is untenable. Moreover, just combining the known general concept of hyperlinking to "Paytable," "See Pays," and "Help" buttons does not increase the speed of the function of seeing payable information and does not provide the present invention including the selection of a specific symbol and the display of the part of the payable associated with that symbol. The Office Action has thus failed to present a *prima facie* case of obviousness.

Since the first two possible sources do not provide a motivation to combine the cited references, the Office Action appears to have, *de facto*, relied upon the remaining source of motivation to combine, which is knowledge of persons of ordinary skill in the art. In support of this conclusion, the following excerpt of the reasons found in the Office Action is reproduced as follows:

[Providing hyperlinks] makes it faster and easier for a user to gain information. The less time spent searching paytables, the more time spent gambling. This leads to greater profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed payable information about a particular symbol when it was chosen by a player via a hyperlink in order to quickly provide information to the player so that the player doesn't have to spend time searching the

paytables and can spend more time gambling – thus increasing casino profits. (Page 5, lines 5-11 of the present office action).

This motivation in the Office Action is a general efficiency/profit rationale to increase gambling time of players and, thus, casino profits. However, this general rationale can be said to be present in many advances in the gaming device art, as well as many other art areas. This generic motivation does not satisfy the required motivation to combine references to achieve the invention required under Federal Circuit law.

Furthermore, this motivation, even if it was considered proper, still would not specifically motivate one of ordinary skill in the art at the time of invention to specifically modify a video slot machine to enable selecting a specific symbol on a reel to display a payable or the part of a payable for that specifically selected symbol as featured in the present claims. The rationale provided by the Office Action falls does not specifically demonstrate why one of ordinary skill in the art would be specifically motivated to make the claimed invention over other apparatus and methods to achieve the end benefit. For instance, video slot machines known in the art at the time of the invention employed player assistance or help screens activated by touch screen selection of a "Paytable," "See Pays," or "Help" input displayed on the screen other than at the location of the specific symbols on the reels (i.e., at a location separate or distinct from the game reels). The addition of a hyperlink to a video slot machine having "Paytable," "See Pays" or "Help" input would simply result in a slot machine providing the currently known feature of displaying payable information. The combination does not suggest providing a new feature wherein the selection of a specific symbol on a reel, such as the touch of touch screen in the area of a displayed reel symbol causes payable information for that specific selected symbol to be displayed to the player. The Office Action has not shown how one of ordinary skill in the art would be motivated to depart from the conventional knowledge in the art to reach this invention.

Without such specific motivation, it appears that the rationale of the Office Action instead relies on impermissible hindsight gleaned from Applicant's disclosure to provide the missing motivation to arrive at the claimed invention. It is well-settled law that obviousness cannot be based on the hindsight combination of components selectively

culled from the prior art to fit the parameters of the claimed invention. *ATD Corp v. Lydall, Inc.*, 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). The Federal Circuit has clearly iterated that:

[v]irtually all inventions are necessarily combinations of old elements. The notation, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate Prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

Panduit Corporation v. Dennison Manufacturing Co., 810 F.2d 1561, 1575 (Fed. Cir. 1987). Moreover, the Federal Circuit has specifically cautioned against from doing exactly what the Office Action in the present application has done:

[a]s this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

....

... To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

Yamanouchi Pharmaceutical Co., Ltd., et al v. Danbury Pharmacal, Inc., et al., 231 F.3d 1339, 1343 (Fed. Cir. 2000) (Rehearing and Rehearing En Banc Denied, December 14, 2000).

When the Patent Office fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been impermissibly made in hindsight. *In re Rouffet*, supra, (citing *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991)). Additionally, the M.P.E.P. mandates that impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned

from the prior art (See M.P.E.P. §2141.03). Although, as stated in case law often relied on by the U.S. Patent Office (See e.g., paragraph A of subsection X of § 2145 of the M.P.E.P.), that “[a]ny judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning” *In re MacLaughlin* 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971), this nonetheless does not relieve the Patent Office of ensuring that the obviousness determination takes into account only knowledge which was with the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned from the applicant’s disclosure. The asserted rejections in the present Office Action do not properly take only knowledge in the art into account, but additionally lift motivation from Applicant’s disclosure as discussed above. Accordingly, it is respectfully submitted that the rejections are using improper hindsight and must be withdrawn.

B. Lemay is Non-analogous Art

Applicant also respectfully submits that Lemay is non-analogous art. Specifically, Lemay relates to web publishing using hypertext mark-up language (HTML) for Web publishing, which is far afield from gaming devices. Furthermore, Lemay is not reasonably pertinent to the particular problem with which Applicant was concerned. As stated in *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q. 2d 1767 (Fed. Cir. 1993) “[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor(s) endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” In the present application, Applicant respectfully submits that the Web publishing manual of Lemay is not a teaching that logically would have commended itself to an inventor’s attention in considering the problem of complicated paytables of gaming machines (as described in the Declaration of Aaron Jones submitted with the previous amendment, which is incorporated herein) and displaying a portion of a paytable for a selected symbol in a clear, easy and immediately obtainable manner. Lemay deals with Web publishing using HTML programming to publish information on the Internet, and one in the art of gaming devices would not

necessarily look to this reference's teachings (i.e., Internet publishing) to solve the problem of displaying complicated paytables concerning symbols of a reel of a gaming device.

Lemay is also not reasonably pertinent to the particular problem solved by the present claimed invention, namely narrowing the displayed payable or other information from the larger exhaustive payable (i.e., narrowing the scope of displayed information pertinent to the information for a particular symbol). Rather, the particular teaching of Lemay relied upon in the present Office Action deals with broadening the scope of displayable information beyond a particular page such that storage space can be minimized (see Lemay, page 11, lines 1-4). Thus, the teachings of Lemay are not reasonably pertinent to problems addressed by the claimed invention.

In light of the foregoing, Applicant respectfully submits that reliance on the teachings of Lemay under 35 U.S.C. § 103 is improper due to the non-analogous nature of the teachings and runs afoul of the mandates of MPEP § 2141.01(a).

The present Office Action also appears to have mischaracterized the above arguments by asserting that Applicant "argues that only 'gaming machine' technology may be used to address problems in the 'gaming machine' art." This is not Applicant's argument. Rather, Applicant is simply pointing out that the PTO must adhere to recognized precedent when relying on art outside of the inventor's immediate area of endeavor (not that "only 'gaming machine' technology may be used") and that the PTO did not do so in this case. More specifically, although Internet technology such as hyperlinking can be applicable to computerized gaming devices, this does not relieve the PTO of the establishing that the particular cited reference (i.e., Lemay, which is directed to Web publishing) would commend itself to an inventor tackling a specific problem such as displaying information about a symbol displayed on a reel in a gaming device, regardless of whether or not the gaming device may utilize computer or Internet technology. This distinction is especially important in an art where, as described above, it is already known to use "Paytable," "See Pays," and "Help" buttons or inputs, which, when activated, cause a display device to reveal the first screen of multiple screens which display the entire payable for all of the symbols. However, the Office Action and

the art of record does not show that resort by an inventor to the particular cited art, which is outside the gaming art, but is likely known, in a general sense, to those in the gaming art, would nonetheless commend itself to the specific problem at hand.

Additionally, the Office Action asserts that context sensitive help is extremely well known in the computing arts and that is a well-recognized solution to the problem presented. The Office Action further adds that the art is filled with examples of programs having context sensitive help where selection of a symbol causes information regarding that symbol to be displayed. It is unclear what particular "art" to which this statement is referring, but the Office Action nonetheless fails to demonstrate, whether in the art of gaming machines specifically or in the computer arts generally, where it was known prior to the present invention to have a gaming device including a controller to display a paytable display for a specific symbol when that specific symbol displayed on a reel is selected. More importantly, merely because hyperlinks or equivalent technologies may be applied to the gaming art, this potential does not render every application of this technology obvious. Otherwise, any relevant invention irrespective of novelty and obviousness would potentially be rendered unpatentable. Such a burden is onerous, unreasonable, and over-reaching. With respect to the particular claimed invention, Applicant submits that the invention of displaying the specific paytable or portion of the paytable for a specific selected symbol on a reel is novel and unobvious.

Additionally, the Office Action asserts that "[v]irtually every facet of human endeavor has been touched by the Internet", including the gaming industry. Based on this sweeping generalization, the Office Action implies Applicant could not reasonably assert that Internet publishing would not be applied to a problem characterized as "displaying what is essentially a list or table" and the Office Action alleges that such a contention cannot survive rigorous examination. Applicant disagrees and submits that the position taken in the Office Action is, in fact, untenable. The Office Action appears to fail to distinguish that a manual of Internet publishing would not readily be a source of motivation to which inventors in the gaming art would resort. Nonetheless, such inventors would most likely be aware of hyperlinking and various technologies used in displaying information. This knowledge alone, however, would not necessarily motivate

one of ordinary skill in the art to arrive at the particular conceptual application of the technology as featured in the claimed invention. Applicant submits that further knowledge was utilized in the reasoning of the Office Action to arrive at the claimed invention, and that further knowledge was gleaned solely from the present application.

Furthermore, the Office Action submits that the claimed "gaming machine" is nothing more than a digital computer. The Office Action asserts that the "problem" addressed is how to efficiently display payable information on a gaming machine "on one level" and efficient display of textual data on a digital computer, "on another level." Regardless of whatever "level" the Office Action wishes to characterize the claims, this does change the burden of the Office to establish a *prima facie* case of obviousness of the claims themselves. Notwithstanding that the gaming devices employ digital computers, this does not relieve the PTO's burden of showing that it would have been obvious for one skilled in the art to modify Heidel to show pay information concerning certain symbols, especially when Heidel only teaches display of a single payable (paytable 18), to achieve the desired benefit. Claim 1, for example, features "at least one payable display for said selected symbol stored in said controller" and "whereby selecting said symbol causes said controller to cause said display device to display a payable display for said selected symbol." A problem of efficiently displaying information on a gaming machine, which may be a computer, does not mean that a solution by one of ordinary skill would necessarily have to include these claimed elements. Thus, hindsight reasoning has been used to make the supposed "small conceptual step", as it is wrongly characterized in the present Office Action.

In the final Office Action, the Examiner alleges that the rejection of the claimed invention is based on a consideration of the invention "as a whole." Applicant submits, however, that the analysis presented in the Examiner's rebuttal indeed fails to consider the claimed invention as a whole. This failure lies in the Examiner's apparent disregard of the art in which Applicant has endeavored (i.e., the gaming machine art), irrespective of whether the claimed invention utilizes computer technology. This disregard appears to be an expedient vehicle to make a rejection and to avoid the diligent task of proving proper motivation. A proper analysis of the claims "as a whole" would not discount that

the present claims are directed to a gaming machine that features, for example, the claimed displaying a payable display for a selected symbol on a reel, not just generic information or not just the entire payable. Although, through apparent hindsight reasoning, the Examiner concludes that “[s]urely, one of ordinary skill in the art would be able to make such a small conceptual step – especially when confronted with the problem and its solution . . . on a daily basis”, the Examiner has not provided sufficient motivation or evidence to show that one of ordinary skill in the art of gaming machines would have contemplated the conceptual solution to the problem based on the knowledge in the art. That is, no sufficient showing is made that one of ordinary skill in the art would have contemplated displaying a payable display for a symbol selected on a reel as a solution to other previously attempted solutions. This lack of showing is further evinced by the declarations of Aaron Jones under 1.132 submitted previously and herewith.

The present Office Action asserted that the declaration under 37 C.F.R. § 1.132 filed with the previous amendment was insufficient to overcome the rejections. Applicant submits that this declaration is believed to present sufficient objective evidence of an unsolved, but long-felt need. The Office Action particularly states that the declaration refers “only to the system described in the above-referenced application and not the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims.” Applicant respectfully disagrees because the declaration indeed referenced the claimed invention, not merely the system described in the present application.

Furthermore, Applicant submits concurrently herewith a supplemental declaration under 37 C.F.R. § 1.132 to the declaration filed in the previous amendment. This supplemental declaration indicates that the invention of the claims satisfies a twenty-five year old long-felt need that was not solved by others. During this time period, the problem of complicated paytables existed in both mechanical and video slot machines and various attempts to effectively address this problem were contemplated. The present invention solves this problem in an effective manner. Applicant submits that this objective evidence of the secondary consideration of long-felt need is relevant to

the issue of obviousness and must be considered (see M.P.E.P. § 2141 and § 716.01(a)). In light of the foregoing objective evidence, Applicant submits that the claims are not obvious in light of the prior art of record.

In connection with and further to the Declarations Under 37 C.F.R. § 1.132 of Aaron Jones filed on December 11, 2002 and concurrently herewith, Applicant previously submitted an article (in a letter to the Examiner) and Applicant hereby submits another article for the Examiner's consideration. In particular, this additional article is from the February, 2003 issue of "Strictly Slots" magazine. The article describes upcoming features that will appear in slot machines in 2003. One game feature from Sigma (i.e., "Smart Touch"), in particular, is described on page 52 as "a feature that will most certainly become an industry standard." The statements made in this article and the previously submitted article provide further objective and independent evidence that supports the statements made in the declarations of Aaron Jones and in this and the previous response that the presently claimed invention solved a long-felt but unmet need in the wagering gaming industry. Moreover such objective and independent statements completely rebut the Examiner's position that the presently claimed invention is a "small conceptual step." Accordingly, it is respectfully submitted that the rejection of Claim 1 should be withdrawn.

Like Claim 1, the Office Action rejected independent Claims 11, 34, 39, 42, 44 and 46 as obvious in view of Heidel, Lemay, and Fey. For the above reasons, the Office Action, therefore, has also failed to establish a prima facie case of obviousness of these claims. The remaining claims 2-8, 12-33, 35-38, 40-41, 43, and 45-48 are submitted to be allowable at least due to their respective dependencies. *In re Fine*, 837 F.2d at 1076 ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious").

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, applicant respectfully requests that the Examiner contact the applicant's attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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